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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,009	12/07/2000	Sven Rothe	41114	3830
7590	10/01/2003			
			EXAMINER	
			JONES, DAVID B	
		ART UNIT	PAPER NUMBER	
		3725	6	
DATE MAILED: 10/01/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,009

Applicant(s)

ROTHE ET AL.

Examiner

David B Jones

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 15-23 is/are pending in the application.

4a) Of the above claim(s) none is/are withdrawn from consideration.

5) Claim(s) ____ is/are allowed.

6) Claim(s) 15-23 is/are rejected.

7) Claim(s) ____ is/are objected to.

8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.

4) Interview Summary (PTO-413) Paper No(s) ____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____.

DETAILED ACTION

1. Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the restriction was made in error in that the application was filed under 35 USC 371 practice and therefor the US rules for restriction do not apply and hence the groups of claims should remain together. This has been found persuasive and claims 15-23 have all been examined below.
2. Claims 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are narrative in form and replete with indefinite and functional or operational language. The structure that goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. It would appear that the claims are a product of translation from a foreign patent document and as such fails to comply with US patent practice. The claims should be reviewed and amended into proper claim format for US practice. In claim 15, "the driving-in" lacks antecedent basis and is awkward in verbiage. Further in claim 15, the limitations, "a cylindrical part, especially into a firing channel" and "a first flexible element, especially by a first helical spring" render the claim indefinite. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by

the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). Hence the two limitations, "a cylindrical part, especially into a firing channel" and "a first flexible element, especially by a first helical spring" recite broad recitations followed by narrower limitations. Finally in claim 15, "the firing bolt lacks antecedent basis. In claim 16, "its end turned toward the rivet" lacks antecedent basis. In claim 17, "the driving-in of the rivet" lacks clear antecedent basis. In claim 18, the "boreholes", "piston", and "joining member", all lack positive recitation in the claim and correlation with the combination. In claim 19, "the joining member" and "the clamping jaws" lack antecedent basis. Further in claim 19, "a guiding sleeve", "an end piece", "a borehole", and "a second flexible element" all lack positive recitation and correlation in the claim. In claim 20, the limitation, "can be moved" "fails to positively and clearly claim the structure of the apparatus. Further, the "cylinder" lacks positive recitation. Claim 21 contains the same failings as the previous claims lacking elements positively recited and structurally correlated with the combination. Further in the claim (21) the limitation "preferably in a handle" fails to positively recite the invention upon which applicant is requesting a patent, hence vague

and indefinite. In claim 22, "the point of the rivet" and "the action" lack antecedent basis. The limitation "latches into the rivet" is indefinite and unclear. What structure is defined that allows for latching and what is defined by the limitation "latching". In claim 23, "its second end" lacks antecedent basis. Finally the limitation in claim 23, preferably is configured in a pyramid shape" render the claim indefinite in that the Applicant fails to positively claim the invention upon which a patent is requested.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by GB Patent 1,128,442. GB '442 teaches the claimed invention as broadly set forth including a firing bolt 39, a striking member 26/27/30/33, flexible element (spring) 37. Regarding claim 16, the member 35/38 is considered to be a centering means as broadly recited.

Regarding claim 17, member 36 is considered to be a buffering means as recited.

4. Claim 22 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Document 2,334,385. See Fig. 7-9 and what are considered catching means on the rivet pin that lie within the jacket 5 (not numbered).

5. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Szayer et al. Szayer et al teaches the claimed rivet and what are considered catching means (44 as seen in Fig. 1), as so broadly and vaguely set forth, on the rivet pin which lies within the jacket 5.

6. Claims 18-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. JONES whose telephone number is (703) 308-1887.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

In the event that the Applicant(s) wishes to communicate via Fax, the current Fax number for Group 3700 is (703) 305-3579

DBJ



DAVID B. JONES
PRIMARY PATENT EXAMINER
ART UNIT 3725